

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket No.: FICHTNER

In re Application of:)
SIEGFRIED FICHTNER et al.) Examiner: Mullins, Burton S
Appl. No.: 10/789,411) Group Art Unit: 2834
Filed: February 27, 2004) Confirmation No.: 5262
For: ELECTRIC MACHINE WITH A LAMINATED ROTOR CORE)

REQUEST FOR REHEARING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA, 22313-1450

S I R:

Appellant requests a rehearing in the above-identified matter, pursuant to 37 C.F.R. §41.52(a)(1) and 37 C.F.R. §41.52 (a)(2). The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 06-0502.

The request for rehearing is filed to address two points of law or fact which appellant feels were overlooked or misapprehended by the Board.

CERTIFICATION OF EFS-WEB TRANSMISSION

I hereby certify that this paper is being EFS-Web transmitted to the U.S. Patent and Trademark Office, Alexandria VA 22313-1450, on March 12, 2007.
Date

Henry M. Feiereisen

(Name of Registered Representative)

(Signature)

3-12-2007
(Date of Signature)

ISSUE 1: THE BOARD FAILED TO PROPERLY CONSTRUCT THE
SUBJECT MATTER OF CLAIM 1

Claim 1, on appeal, is an apparatus claim setting forth a combination of claim elements. One claim limitation is the provision of a plate attached to an end surface of a rotor core and allowing an axial deflection of the laminations.

In affirming the Examiner's rejection of claim 1, the Board states with respect to the Carlson reference that "*once the pressure of the press [is] released after inserting the washers*", the lamination also tend to open up. The Board further stated that "*Carlson describes the way the laminations tend to open up as exerting force on the washers is removed*". Thus, the Board concluded that the claim limitation of "axial; deflection" is disclosed in Carlson.

The error in this argumentation by the Board resides in the fact that the Board appeared to treat claim 1 as a process claim. Even if, for argument's sake, the laminations in Carlson indeed are able to deflect axially when the pressure on the washers, as applied by a press or other power means, is removed, this axial deflection occurs, if at all, during the manufacture of the Carlson assembly comprised of rotor shaft and laminations. In fact, the entire disclosure of Carlson is directed to a method of securing laminations on a rotor shaft but not to the assembly as such. Once the assembly is manufactured, the washers, after having been flattened by the press against the laminations, dig into the shaft so as to establish a secure mounting of the laminations on the shaft. In the finished product, the laminations in the Carlson reference cannot move at all, neither axially inwardly nor axially outwardly. This is also clearly shown in Fig. 4.

In contrast thereto, the finished product according to the present invention, as set forth in claim 1, allows an axial deflection of the laminations, even after the plates have been attached. As claim 1 is an apparatus claim and NOT a process claim, the possibility of an axial deflection during manufacture of a product is immaterial as to the patentability of claim 1 at hand, unless the prior art discloses a

finished product that also allows such an axial deflection of the finished product. This, however, is clearly not the case in Carlson.

The Board is therefore requested to reconsider the affirmation of the rejection of claim 1 and reverse the Examiner's rejection of claim 1.

ISSUE 2: THE BOARD IGNORED THE DOCTRINE OF CLAIM DIFFERENTIATION

In its Decision, the Board noted that *"we remain unconvinced by Appellants' argument that because dependent claim 15 requires that the inner diameter of the plate bear upon the shaft, claim 1 should be construed in the opposite way such that the plate extends shy of the outer surface of the shaft."*

Appellant wishes to draw the Board's attention to two decisions rendered recently by the CAFC, namely *Dupuy Spine, Inc. v. Medtronic Sofamour Danel, Inc.*, 60 USPQ2d 1865 (November 20, 2006), and *Andersen Corp. v. Fiber Composites LLC*, 81 USPQ2d 1545 (January 26, 2007). As noted in *Andersen*, the doctrine of claim differentiation is based on *"the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope."* The Court continues: *"To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant."*

In claim 1, on appeal, the plate is claimed as "extending to an area of the shaft". Claim 15, dependent on claim 1, sets forth that "the plate has an inner diameter so as to bear upon an outer diameter of the shaft".

Claim 15 thus relates to a contact between the plate and the shaft. It then follows under the doctrine of claim differentiation that claim 1 has to be broader so that the claim limitation of "extending to an area of the shaft" can only mean that no contact exists between the plate and shaft. The Board is thus incorrect, when

noting that independent claim 1 sets forth a contact between the plate and the shaft and merely fails to specify "*the manner in which it contacts the shaft*".

Appellant further wishes to emphasize that the Carlson assembly in its final configuration has washers that penetrate the outer surface of the shaft. In other words, the washers do not have an inner diameter to bear on the shaft surface, as set forth in claim 15.

The Board is therefore requested to reconsider the affirmation of the rejection of claims 1 and 15 and reverse the Examiner's rejection of claims 1. and 15.

Respectfully submitted,

By: 

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